Supreme Court, U.S.
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No. 99-150

IN THE

Supreme Court of the United States

WAL-MART STORES, INC.,

Petitioner,

v.

SAMARA BROTHERS, INC.,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF FOR PETITIONER

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QUESTION PRESENTED

What must be shown to establish that a product's design is inherently distinctive for purposes of Lanham Act trade dress protection?

PARTIES TO THE PROCEEDING AND STATEMENT PURSUANT TO RULE 29.6

All parties in the Court of Appeals are designated in the caption. Petitioner Wal-Mart Stores, Inc. does not have a parent company and no publicly held company owns 10% or more of the stock of Wal-Mart Stores, Inc.

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The opinion of the District Court is reported at 969 F. Supp. 895 (S.D.N.Y. 1997), and reproduced as Appendix B to Wal-Mart Stores, Inc.'s Petition for a Writ of Certiorari ("Pet."). The opinion of the Court of Appeals is reported at 165 F.3d 120 (2nd Cir. 1998), and reproduced as Appendix A to the Petition. The unreported Order of the Court of Appeals denying rehearing and rehearing en banc is reproduced as Appendix D to the Petition.

JURISDICTION

Jurisdiction in this Court is founded on 28 U.S.C. § 1254(1) in that this is a review of a decision of the Court of Appeals for the Second Circuit. The judgment of that Court was entered on December 28, 1998. (Pet. App. A.) A timely Petition for Rehearing was filed on January 11, 1999, and was denied on April 21, 1999. (J.A. 11; Pet. App. D.) A timely petition for a writ of certiorari was filed on July 20, 1999 and granted by Order entered October 4, 1999.

STATUTORY PROVISIONS INVOLVED

This case involves the scope of protection provided for the configuration of goods in a line of products claimed as trade dress under § 43(a)(1) of the Lanham Act, 15 U.S.C. § 1125(a)(1), which provides a cause of action against any person who:

> on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, which –
>
> > (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the

> origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person….

Section 2 of the Lanham Act, 15 U.S.C. § 1052, permits registration of a "trademark" on the principal register under the following terms:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
>
> * * *
>
> (e) consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them… (5) comprises any matter that, as a whole, is functional.
>
> (f) …nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive… proof of substantially exclusive and continuous use thereof as a mark by the applicant for… five years….

Section 23(c) of the Lanham Act, 15 U.S.C. § 1091(c), permits registration of "a mark" on the supplemental register under the following terms:

> For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is

> not functional, or any combination of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

Section 45 of the Lanham Act, 15 U.S.C. § 1127, defines a "trademark" for purposes of the Lanham Act as including:

> any word, name, symbol, or device, or any combination thereof… used by a person… to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

STATEMENT OF THE CASE

This case involves the scope of protection under §43(a) of the Lanham Act, 15 U.S.C. § 1125(a), for product configurations – here, children's seersucker clothing adorned with a variety of appliqués depicting common themes such as flowers, fruits, and hearts. The case comes before the Court on a petition granted to review a divided decision of the Second Circuit. That court affirmed a trial court judgment that the plaintiff, Samara Brothers, Inc. ("Samara") had an "inherently distinctive," and thus protectable, trade dress in the "look" of its children's apparel, and that the defendant, Wal-Mart Stores, Inc. ("Wal-Mart"), infringed that trade dress by selling similar goods.

Samara is a manufacturer of children's clothing, some sold to consumers under its own "Samara" label, and some sold to consumers under the labels of Samara's retail store customers, such as Belk, Carters, and Atkins. (J.A. 39-41.) Wal-Mart is a national chain of retail stores that sells, among other items, children's clothing, which it purchases from third-party vendors. (Pet. App. A at 2.)

In 1996, Samara learned that Wal-Mart's vendor, Judy-Philippine, was manufacturing and selling to its retail store customers garments that resembled Samara's styles. (J.A. 15.) Before suing, Samara obtained copyright registrations for certain of its appliquéd designs – such as strawberries, hearts, and daisies – and/or for the layout of such appliqué designs on collars and pockets, as displayed on children's seersucker clothing.[1] (J.A. 36-37.) Samara then filed suit against Judy-Philippine and five of Judy-Philippine's retail customers, including Wal-Mart. (J.A. 1; *see also* J.A. 12-23.) Samara asserted several different causes of action – specifically, federal copyright claims, claims under § 43(a) of the Lanham Act, and state law claims. (J.A. 17-22.) Shortly before trial, all defendants except Wal-Mart settled. (*See* J.A. 273-77.)

At trial, Samara sought damages for Wal-Mart's sale of: (1) garments that incorporated copyrighted elements; and (2) other garments that did not incorporate copyrighted elements, but which were claimed to be part of a protectable "Samara look." (J.A. 201-204.) With respect to the latter claim – the trade dress claim – Samara contended that its "look" was inherently distinctive under the Lanham Act and that the sale of similar products by Wal-Mart produced confusion in the minds of consumers as to the source of Wal-Mart's goods (*i.e.*, consumers buying the garments sold by Wal-Mart thought they were buying Samara's products). (J.A. 20.) Samara offered no evidence of actual confusion among consumers. (J.A. 131; *see also* Pet. App. B at 49.) It relied instead on evidence that Wal-Mart knew that its vendor copied Samara's styles and that Wal-Mart thus intended to deceive customers. (*See* Pet. App. B at 49.)

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[1] A copyright must be registered before a copyright infringement action may be brought thereon. *See* 17 U.S.C. § 411.

The jury found for Samara on all counts. (J.A. 149-54.) It awarded $912,856.77, representing Wal-Mart's profits, for infringement of thirteen copyrighted Samara appliqué designs. (J.A. 150-52.) The jury also awarded $240,458.53 under the Lanham Act for copying the trade dress of Samara's clothing line, based on sales of other garments similar to non-copyrighted Samara styles. (J.A. 152.) The District Court entered an injunction which prohibited Wal-Mart from selling garments, which copied, "directly or indirectly," Samara's garments or appliques, or which were designed "using any Samara garment, applique, or applique arrangements or combinations as a source or basis." (Pet. App. C at 57.)

During the trial, Wal-Mart moved for Judgment as Matter of Law. That Motion was reserved and eventually denied when it was renewed after the verdict was rendered. (Tr. 707.) The appeal to the Second Circuit challenged the denial of the Motion for Judgment as a Matter of Law and also raised other issues not within the scope of the Question Presented. After briefing and argument, the Court of Appeals for the Second Circuit affirmed in part and reversed in part in a 2-to-1 decision authored by Judge Parker and joined by visiting Judge Carman from the International Court of Trade.[2] (Pet. App. A.) The majority rejected the trade dress claim for two of the sixteen garments sold by Wal-

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[2] On September 20, 1999, Judge Carman informed the parties that he had recently learned that his wife owned Wal-Mart stock during the course of this appeal. (J.A. 11.) He promptly removed himself from any further participation in the case, including the pending consideration by the Court of Appeals of Samara's request for attorney's fees in connection with the appeal. Because Judge Carman did not know of his wife's ownership at the time he participated in the appeal, the appellate decision itself has not been affected by his subsequent recusal. Wal-Mart has informed Judge Carman that it will take no action on the matter. (J.A. 328.)

Mart, but upheld the balance. (Pet. App. A at 7-22.) In so doing, the majority crafted its own articulation of Samara's trade dress and instructed the trial court on how to fashion an injunction. (*Id.* at 18-20.)

Senior Judge Newman dissented and would have reversed the entire trade dress judgment, concluding that the "look" of Samara's line of dresses was not distinctive. (Pet. App. A at 31-32) ("On the facts of this case, it was not reasonable to find distinctiveness of Samara's entire product line."). Judge Newman also would have reversed the jury verdict and judgment on several of the copyright claims. (*Id.* at 39-41.) A timely Petition for Rehearing and Rehearing en Banc was filed, and denied in an Order entered on April 21, 1999. (Pet. App. D.) On remand, the trial court entered an injunction that largely tracked the appellate court's opinion. (*See* Pet. App. D. at 18-20 (appellate opinion) and J.A. 283-327 (final judgment with attachments)).

This is one of the increasingly common cases in which a manufacturer does not have a patent, a copyright, or a registered trademark, but instead seeks to protect, under § 43(a) of the Lanham Act, a claimed trade dress in the configuration of products comprising a line of goods. In these cases, the owner often claims that the product configurations are "inherently distinctive," and that, as a result, the owner need not prove that customers view the configurations as an indicator of the source of the goods.

The trade dress claimed here is based entirely on the visible features of the garments themselves. It is not based on any word, term, name, singular symbol, or singular device; nor is it expressed in the packaging of the products. Rather, the trade dress claim is based upon the elements that constitute the products themselves – "conservative" children's garments made of seersucker fabric, with a variety

of "large, bold" appliqués, which are often placed in the collar. (*See* Pet. App. A at 13.)

Here, the claimed trade dress varies significantly from garment to garment. It has defied easy definition, as the textual description of the claimed trade dress has changed regularly over the course of this case – from complaint (J.A. 14-15), to opening statement (J.A. 25-26), to proposed injunction (J.A. 279-81), to the initial injunction (Pet. App. C at 57), to the Court of Appeals decision (Pet. App. A at 18-20), and to the final injunction (J.A. 284-85). Prior to this litigation, there had never been any articulation of the "Samara look" that comprises the alleged trade dress. And, as the Court of Appeals observed, there is no claim that the trade dress has acquired secondary meaning.[3] (Pet. App. A at 8) ("At the outset, we note that there is no assertion in this case that Samara's seersucker garments have acquired 'secondary meaning' in the marketplace.")

In short, this is the vexing type of product configuration case that has caused a pronounced split in the Circuits and among legal commentators as to what must be established to obtain protection under the Lanham Act for a product configuration. As noted recently by Judge Posner, "[t]he courts [in product configuration cases] have struggled to articulate a standard for when a trade dress is sufficiently distinctive to be entitled to a prima facie protection of the Lanham Act." *Publications Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 (7th Cir. 1998), *cert. denied*, 119 S. Ct. 1498 (1999).

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[3] As defined by this Court, "'secondary meaning' is acquired when 'in the minds of the public, the primary significance of a product feature… is to identify the source of the product rather than the product itself.'" *Qualitex Co. v. Jacobsen Products Co.*, 514 U.S. 159, 163 (1995).

SUMMARY OF ARGUMENT

1. The starting point for analysis of the question presented is the text of the Lanham Act itself. The Act, in § 23(c), sets out that a "configuration of goods" be treated as a mere "mark" which, standing alone, may only be registered on the supplemental register. 15 U.S.C. § 1091(c). A configuration of goods mark, it would appear, can only cross-over to "trademark" status, and obtain the benefits of registrability awarded by the Lanham Act, on proof of secondary meaning. 15 U.S.C. §§ 1052 (e) and (f). This interpretation is consistent with the legislative history, which shows that members of Congress did not intend for product configurations to be accorded "trademark" status absent secondary meaning. Because there is no secondary meaning, under this reading of the statute the claimed Samara trade dress is not registrable. As it is not registrable as a trademark under § 2, it is not protectable under § 43(a) of the Act, 15 U.S.C. § 1125(a). *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

If the Court does not accept this statutory construction, it should turn first to traditional law to determine whether a mark is "inherently distinctive." Under the *Abercrombie* test (*Abercrombie & Fitch, Co. v. The Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), discussed in both *Two Pesos*, 505 U.S. at 768, and *Qualitex Co. v. Jacobsen Products Co.*, 514 U.S. 159, 163 (1995), the result is the same: a product configuration cannot be inherently distinctive. A product configuration is not arbitrary, fanciful, or suggestive of a relationship between the trade dress and the product: the dress is the product. Under *Abercrombie*, a product configuration trade dress is "descriptive." By law, "descriptive" trade dress is only registrable under § 2, and hence protectable under § 43(a), on proof of secondary meaning. Product configuration is thus just like color in the

distinctive spectrum – it requires secondary meaning to be protectable. *See Qualitex*, 514 U.S. at 163.

2. If this Court chooses to articulate a different test than *Abercrombie*, Wal-Mart suggests this: an "inherently distinctive" product configuration is a *consistent and particular design that is so unique as to be automatically, immediately, and primarily perceived as indicating the origin of the goods*. This test is drawn from this Court's precedent, appellate court decisions, legal treatises, the Restatement of Unfair Competition, and the manual used by trademark examiners to assess registrability of marks.

3. Under any test, Samara's trade dress is not inherently distinctive. Each garment in the Samara line is materially different from the next – there is no consistency. In three years of active litigation, neither Samara nor the lower courts have been able to define the trade dress with particularity. Nor is the trade dress "unique" in a source identifying way. The elements are all common – seersucker fabric in a variety of hues, appliques of common shapes, ric rac, collars, and simple shapes. No reasonable person looking at the apparel would automatically and immediately conclude that the primary purpose of the design was to identify the maker. Rather, the immediate appeal is purely aesthetic.

ARGUMENT

I.

A PRODUCT'S CONFIGURATION IS, BY STATUTE AND JUDICIAL PRECEDENT, "DESCRIPTIVE" OF THE PRODUCT AND CAN NEVER BE "INHERENTLY DISTINCTIVE" FOR PURPOSES OF § 43(A) OF THE LANHAM ACT.

In its two most recent pronouncements in the field of trademarks and trade dress, this Court has established some clear principles. First, some trade dress may be "inherently distinctive" under § 43(a) of the Lanham Act. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774-776 (1992). In such cases, proof of secondary meaning is not required. *Id.* Second, there are nonetheless some categories of trademarks – and, by necessary implication, some categories of trade dress – that can never be "inherently distinctive." *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-63 (1995). In *Qualitex*, this Court held that an applicant seeking to register a color as a trademark must always demonstrate secondary meaning, because a color cannot be inherently distinctive: "A product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost *automatically* tell a customer that they refer to a brand." *Id.* (emphasis in original).

Careful consideration of those opinions and the text of the Lanham Act itself demonstrate that, like color, a product configuration can never be "inherently distinctive." Employing the traditional *Abercrombie* rubric of trademark classifications, a product's configuration is always "descriptive" of the good – it is, in fact, the good itself. Thus, a product configuration can obtain protection under the Lanham Act only if the plaintiff can demonstrate secondary meaning.

While this proposition may appear bold, it is advanced only after close examination of the statute, this Court's precedent, other appellate court decisions, and the policies underlying the Lanham Act.

A. The Literal Text Of The Lanham Act Suggests That Secondary Meaning Is Required In Product Configuration Cases.

In starting an analysis of the scope of protection under § 43(a), "[i]t is appropriate to begin with the relevant text...." *Two Pesos*, 505 U.S. at 777 (Stevens, J., concurring). A brief tour of the Lanham Act suggests that Congress, in enacting the statute, determined that product configurations require secondary meaning to be protectable.

The entire Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, has three separate subchapters: (1) the principal register (§§ 1-22); (2) the supplemental register (§§ 23-28); and (3) general provisions (§§ 29-51). The first subchapter discusses registration on the principal register. Registration on that register confers significant advantages over unregistered marks: priority over other persons on a nationwide basis (§§ 7(c) and 22, 15 U.S.C. §§ 1057(c) and 1072); foreign priority pursuant to treaties[4]; U.S. Customs Service exclusion of infringing imports (§ 42, 15 U.S.C. § 1124); incontestable status (§ 15, 15 U.S.C. § 1065); and, perhaps most important, *prima facie* evidence of validity and ownership (§ 7(b), 15 U.S.C. § 1057(b)). *See Qualitex*, 514 U.S. at 174 (discussing advantages of registration: "Trademark law helps the holder of a mark in many ways that 'trade dress' protection does not.").

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[4] *E.g.*, Article 4 of the International Convention for the Protection of Intellectual Property, 25 Stat. 1372, T.S. No. 379 (Paris Convention) as revised, 21 U.S.T. 1629, 1631, T.I.A.S. No. 6923, 828 U.N.T.S. 107 (Stockholm text).

The second subchapter of the Act pertains to registration on the supplemental register. Registration on that register is available to certain "marks" which, while "capable" of distinguishing an applicant's goods (§ 23(c), 15 U.S.C. § 1091(c), are "not registrable on the principal register...." Section 23(a), 15 U.S.C. § 1091(a). Registration on the supplemental register does not bestow the same benefits of *prima facie* validity, ownership, exclusive rights, nationwide priority, constructive use, incontestability, or Customs Service protection. 2 Jay. R. Dratler, Jr., *Intellectual Property Law* § 11.03(6)(b) (1999 ed.).

The third subchapter contains remedies for infringement of *registered* marks (*e.g.*, § 32, 15 U.S.C. § 1114), and, of particular note here, a remedy for two kinds of unfair competition under § 43(a), 15 U.S.C. § 1125(a). Section 43(a) addresses two separate types of claims: (1) infringement claims without regard to whether there is a registration, § 43(a)(1)(A); and (2) unfair advertising claims, § 43(a)(1)(B).

This Court has definitively connected the registrability provisions of the Lanham Act to the scope of protection found in § 43(a):

> [I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).

Two Pesos, 505 U.S. at 768. Stated another way, an unregistered trademark for which protection is sought under § 43(a) of the Lanham Act should be a mark that would

qualify for registration under § 2 of the Lanham Act – the section pertaining to the principal register.[5]

What do the registrability provisions of the Lanham Act inform us about the scope of protection under § 43(a) for product configurations? As a preliminary matter, and as emphasized in both *Two Pesos* and *Qualitex*, if the literal text of the Lanham Act does not explicitly differentiate between subject matter – *e.g.*, between "trade dress" and "trademark," or between "color" and any other identifier – then the Court will presume that Congress meant no distinction in those terms. *Two Pesos*, 505 U.S. at 774 (no "textual basis" for treating "inherently distinctive verbal or symbolic trademarks differently from inherently distinctive trade dress"); *Qualitex*, 514 U.S. at 162 (a literal reading of the statute does not treat color different than a shape, sound, or fragrance). Absent different textual treatment, a product configuration is like any other "mark" whose owner seeks trademark protection.

But, unlike "color" and "trade dress," the text of the Lanham Act and its legislative history *do* specifically address the term "configuration." Section 23(c) of subchapter 2 of the Lanham Act, pertaining to registration of marks on the supplemental register, says that a "mark," as distinguished from a "trademark," may consist of, *inter alia*, the "configuration of goods," if such *mark* is "capable of

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[5] A majority, but not all, of this Court appear to view the registrability standards of the Lanham Act as applicable to assessing the strength of an unregistered mark under § 43(a). *Compare Two Pesos*, 505 U.S. at 768 (majority opinion) with *id.* at 784 (Stevens, J.)(concurring in judgment and agreeing that "§ 43(a) is properly understood to provide protection in accordance with the standards for registration in § 2") and with *id.* at 787 (Thomas, J.) (concurring in judgment but noting that an interpretation of § 43(a) may be made "without regard to the rules that apply under the sections of the Lanham Act that deal with registration.").

distinguishing the applicant's goods or services." 15 U.S.C. § 1091(c). Essentially, the Lanham Act says that all trademarks are "marks," but not all "marks" may be "trademarks." And, it would appear, a product configuration is listed as a "mark" destined for the supplemental register unless and until the owner can prove that the mark acquired distinctiveness by proof of secondary meaning.

This is the only mention of "configuration" in the statute, and an examination of the legislative history shows that Congress specifically intended that a "configuration" could not serve as a "*trade*mark" without proof of secondary meaning. Stated another way, Congress made the judgment that product configurations were not inherently distinctive trademarks.

This analysis of the statute is bolstered by the legislative history. Congress enacted trademark legislation as early as 1870. The first comprehensive Trademark Act was enacted in 1905. It provided for a single register for trademarks and stated that if a mark were merely descriptive, it could not be registered. In 1920, Congress enacted the first provision for a "supplemental register" to implement provisions of the 1910 Buenos Aires Treaty and conform U.S. law with the trademark practices of other countries, which provided protection to "descriptive" as well as "distinctive" marks. *See Hearings on H.R. 9041 Before the Subcom. on Trademarks of the House Comm. on Patents, 75th Cong., 3d Sess.*, 181 (1938) (additional comments of Earl Thomson introduced by Fritz G. Lanham).

The 1920 provision allowed registration of "other marks not registrable under" the 1905 Act. *See* Trademark Act of 1920, Ch. 104, § 1, 41 Stat. 533. That language reflected a fundamental dichotomy in trademark law that persists today. "Marks" consist of any content that has the capacity to identify the source of goods or services. Under

the 1920 Act, a "mark" was registrable on the "principal register" as a "trademark" if it was inherently distinctive of the source of the goods. If a particular mark was *capable* of becoming distinctive of a specific source, but had not yet become so identified with a unique source, then it could only be registered on the "supplemental register."[6]

"Before 1946, product features ([such as] the shape, configuration, or design of a product) were not protected as trademarks and received protection, if at all, only under the doctrine of unfair competition."[7] Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 Emory L.J. 367, 375 (1999). "The provision for registration of 'configuration of goods" appeared in trademark laws for the first time in [§ 23 of] the Lanham Act." L. Amadur, *Trade-Mark Law and Practice*, § 8.2 at 80, 81 (1959 ed. Supp.). The term "configuration of goods" was first discussed in amendments considered in 1938. The proposed amendment clearly drew a distinction between "trade-marks" and "[m]arkings other than trade-marks… such as labels, packages, and configuration of goods." *Trademark Monopolies,* 48 Emory L.J. at 375. Such other markings were denied registration on the principal register because they were merely descriptive of the goods and not distinctive as to the source of those goods.

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[6] The 1920 Act "did not expressly provide… that the mark to be registrable, be capable of distinguishing applicants' goods (or services) – *i.e.*, possess trade-mark significance – although this was a requirement imposed by the Patent Office." Leon Amadur, *Trade-Mark Law and Practice*, § 8 at 668-669 (1st ed. 1948). The 1946 Act expressly placed that requirement in the statute itself.

[7] Common law unfair competition protected a product's trade dress only when it was shown that the configuration had attained "secondary meaning" as was perceived in the marketplace as a designation of source. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 158 (1989).

Similar discussion in 1939 included the comment that the "configuration of goods" concept encompassed only non-distinctive marks and "extended away beyond any trade-mark law." *Hearings on H.R. 4744 Before Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess.* 126 (1939). One discussion between Mr. Rogers and Rep. Lanham explained that the purpose of the "configuration of goods" language was to permit registration in foreign countries of a registration certificate not otherwise available under U.S. trademark law. *See id* at 125-137.[8]

In those and later hearings, legislators specifically discussed configuration of goods and specifically noted that configurations could only become trademarks registrable on the principal register if they acquired distinctiveness.[9] In the

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[8] "They do not have the same concept of trademarks down there [in Argentina] that we have; they regard, many of them, as trade-mark subject matter things that we consider designs.... Configuration of goods... the shape of a perfumery bottle... would be a design patent here. If we cannot get registration in this country for that sort of configuration we cannot get any protection in Argentina."); *see also Hearings on H.R. 9041 Before the Subcommittee on Trademarks of the House Committee on Patents*, 75th Cong., 3rd Sess. 181 (1938) (discussion between Mr. Rogers and Rep. Lanham).

[9] *See, e.g., Hearings on H.R. 4744 Before the Subcommittee on Trademark of the House Committee on Patents*, 76th Cong., 1st Sess. 126 (1939) (comments of Mr. Fuldner that adding "label, symbol, configuration of goods, slogan or phrase" was a "broad definition of a mark on the supplemental register which may, when it becomes distinctive of the goods, get on the principal register"); *id.* at 130 (Mr. Rogers: "There are a lot of marks that cannot qualify on the principal register; there are a lot of marks that have not become distinctive yet, but maybe will become later and, when they do, they can be transferred over into the principal register"); *id.* at 131 (Mr. Whitman: "[w]e should be very careful not to encourage the adoption and use by business of marks of this character, that is, the configuration of goods.... We have that provision on the principal register for filing descriptive marks... [which] may start out as bad marks... but, as soon as they become distinctive of many goods, they acquire a different meaning."); *see generally*

1946 legislation eventually adopted, Congress permitted registration on the supplemental register of any "mark" and stated that it "may consist of any trade-mark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services." *See* Lanham Act of 1946, Section 23, Pub. L. No. 489, 60 Stat. 540 (1946). That language plainly distinguished between "trade-marks" and a "configuration of goods." A fair reading of the Act and its history is that Congress considered a "configuration" as a "mere mark" which could not be a trademark without proof of secondary meaning.[10]

In subsequent years, Congress adopted certain amendments to § 23 without altering the reference to "configuration of goods." In the most significant overhaul to the Lanham Act, the Trademark Law Revision Act of 1988, P.L. 100-667, 102 Stat. 3935, Congress made some technical

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Trademark Monopolies, 48 Emory L.J. at 376-82 and nn. 8, 39-46 (discussing legislative history and concluding that it would be "absurd" to contend that "Congress intended . . . to recognize trade dress as registrable trademarks and to eliminate the secondary meaning and functionality requirements.")

[10] Simply because a mark is initially eligible for registration on the supplemental register does not mean that it could never *acquire* distinctiveness. Rather, the point of the observation is that, by statute, a product configuration cannot be inherently distinctive, and, as a matter of law, must acquire secondary meaning before it may be registered on the principal register. *See generally Application of Minnesota Mining and Manufacturing Co.*, 335 F.2d 836, 839 n.4 (C.C.P.A. 1964) (Rich, J.) (construing § 23 in a product configuration case and allowing registration on the supplemental register of a mark which "consists of the shape, all of it, and nothing more."). In that case, registration was permitted because the supplemental register does not require proof of secondary meaning, only that the mark might be "capable" of distinguishing source. *See* 15 U.S.C. § 1091(c).

amendments to § 23 which "will have no effects on the underlying rights of the registrant." S. Rep. No. 100-515, 100th Cong., 2nd Sess. 36 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5599. While there is some reference in the 1988 legislative history to registration of a "configuration of goods," there is no indication that Congress believed that any configuration of goods could, or could not, be considered "inherently distinctive."[11]

This legislative history supports the proposed construction of the Act: marks that consist of the configuration of the goods are never inherently distinctive and cannot be registered on the principal register unless and until it is shown that the mark has acquired secondary meaning.[12]

[11] S. Rep. No. 100-515, 100th Cong., 2nd Sess. 36 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603 (Section 43(a) "has been applied to cases involving the infringement of unregistered marks, violations of trade dress and certain nonfunctional configurations of goods and actionable false advertising claims"); *see id.* at 5607 ("The revised definition [of trademark] intentionally retains... (iv) the words 'symbol or device' so as not to preclude the registration of colors, shapes, sounds or configurations *where they function as trademarks*"). (Emphasis added). This statement in the legislative history was reviewed, and relied upon, in *Qualitex*, 514 U.S. at 172-173. The statement does not support an argument that Congress has determined that product configurations could ever be inherently distinctive. Indeed, the *Qualitex* opinion, mindful of the identical passage, explicitly required secondary meaning before a color could be protected as a trademark. The same analysis applies here for product configurations claimed to be protectable as trade dress.

[12] Finally, this construction is supported by a closer comparison of the text of § 43(a) and § 45, which defines a "trademark." The subject matter of § 43(a)(1) is any "word, term, name, symbol, or device or any combination thereof." This scope is virtually identical to the statutory definition of a "trademark" found in § 45 of the Act – "the term trademark includes any word, name, symbol, or device of any combination thereof." 15 U.S.C. § 1127. By implication, if something cannot *qualify* for "trademark" protection, it cannot be protected under the Lanham Act. As we have demonstrated, a product configuration can only serve as a "trademark" if there is secondary meaning. The omission of "configuration of goods" in these sections, and the inclusion of that term in the definition of a "mark" contained in the supplemental register subchapter, supports the notion that Congress intended that a product configuration "mark" could, at best, qualify to become a "trademark" *only* upon proof of secondary meaning.

B. Judicial Precedent Confirms That Product Configurations Are "Descriptive" And, Hence, Not Protectable Under The Lanham Act Absent Secondary Meaning.

The principal purpose of trademark law is to protect a mark "that distinguishes a firm's goods and identifies their source...." *Qualitex*, 514 U.S. at 166. The law will only protect a mark that is sufficiently distinctive to identify a source. *Id.* In both *Two Pesos* and *Qualitex*, this Court referred to the "classic formulation" used to classify marks by a range of distinctiveness: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; and (5) fanciful. *Two Pesos*, 505 U.S. at 768; *Qualitex*, 514 U.S. at 163 (citing *Abercrombie & Fitch, Co. v. The Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976) (Friendly, J.)). "The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive...." *Two Pesos*, 505 U.S. at 768.

Only distinctive marks are registrable and hence protectable under the Lanham Act. *Id.* at 768-69. A "generic" mark, which refers to the "genus of which the particular product is a species," is never distinctive, never registrable, and hence never protectable under the Lanham Act. *Id.* (citation omitted). A "descriptive" mark is one that merely describes the product; it "identifies a characteristic or quality of an article... such as its color, odor, function, dimensions, or ingredients." *Zatarains, Inc. v. Oak Grove*

Smokehouse, Inc., 698 F.2d 786, 790 (5th Cir. 1983) (citation omitted). It can only be registered, and hence protected under the Lanham Act, if it has acquired secondary meaning. *Two Pesos*, 505 U.S. at 769.

A "suggestive" mark hints at or suggests, but does not describe, the nature, quality, characteristics of the products with which they are used. It requires "imagination, thought, and perception to reach a conclusion as to the nature of the goods." *Abercrombie*, 537 F.2d at 11 (quoting *Stix Products, Inc. v. United Merchants & Manufacturers, Inc.*, 295 F.Supp. 479, 488 (S.D.N.Y. 1968)). And, an "arbitrary or fanciful" mark is one that is sometimes made up and always arbitrary to the product; the term does not bear a relationship to the product. *See, e.g., Pebble Beach Co. v. Tour 18 Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998).

There is a clear split in the circuits as to whether these so-called "*Abercrombie*" factors should be applied in product configuration cases. The Eighth, Fifth, and Fourth circuits all hold that the *Abercrombie* factors govern in a product configuration case. *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995); *Pebble Beach Co. v. Tour 18 Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998); *Ashley Furniture Industries, Inc. v. Sangiacomo N.A., Ltd.*, 187 F.3d 363, 370 (4th Cir. 1999). These opinions generally contend that this Court, in *Two Pesos*, held that *Abercrombie* applies in all trade dress cases, regardless of whether the case is one of packaging or configuration, and regardless of whether it involves an individual product or a line of products. *E.g.*, *Stuart Hall*, 51 F.3d at 788.

On the other hand, both the Second and Third circuits have declared that the *Abercrombie* test makes no sense in a product configuration case. The Third Circuit, in *Duraco Products, Inc. v. Joy Plastic Enterprises Ltd.*, 40 F.3d 1431, 1434 (3d Cir. 1994), stated the proposition most eloquently:

> We conclude that traditional trade dress doctrine does not 'fit' a product configuration case because unlike product packaging, a product configuration differs fundamentally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product). In other words, the very basis for the trademark taxonomy – the descriptive relationship between the mark and the product along with the degree to which the mark describes the product – is unsuited for application to the product itself.

The *Duraco* court adopted a different test to determine whether a product configuration is inherently distinctive: "a product configuration… must be (i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product."[13] *Id.* at 1449-50.

The Second Circuit, in two cases preceding the instant one, also rejected the application of the *Abercrombie* factors to a product configuration case. *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 378 (2d Cir. 1997) and *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1007-1008 (2d Cir. 1995). As stated in *Landscape Forms*, "it does not 'make sense' to apply the *Abercrombie* test directly to product design or product configuration cases." 113 F.3d at 377-78 (quoting *Knitwaves*, 71 F.3d at 1007). Agreeing with the Third Circuit, the Second Circuit observed that, in contrast to verbal marks, "one cannot meaningfully ask whether a product design's features are generic or otherwise descriptive of the product itself…." *Id.* at 378. The Second Circuit also proposes an alternative test:

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[13] The Eighth Circuit expressly rejected this formulation in *Stuart Hall*, 51 F.3d at 787.

"whether the design was likely to be understood as an indicator of the product's source." *Id.* To implement that test, the Second Circuit viewed as "useful tools" the factors set out in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977). *Landscape Forms*, 113 F.3d at 378 n.3.

Finally, the First Circuit has adopted a middle ground. *See I.P. Lund Trading v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998). That appellate court rejected the invocation of the *Abercrombie* factors, but also rejected the Second and Third Circuits' contention that there is a distinction between product configuration and other trade dress claims. Rather, the First Circuit adopted outright the *Seabrook Foods* test. *I.P. Lund*, 163 F.2d at 40. According to the First Circuit, *Seabrook Foods* asks "whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin – a trademark."[14] *Id.* (citing 1 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:13 (4th ed. 1996)).

If the Eighth, Fifth, and Fourth Circuits are correct that the *Abercrombie* factors should be applied to product configuration cases, it is apparent that, as with color, a product configuration can *never* rise above the category of "descriptive." A review of the *Abercrombie* factors as applied by the Fifth Circuit in the product configuration case, *Pebble Beach*, *supra*, illustrates this point. There, the Defendant, Tour 18, created golf courses consisting of golf holes copied from famous golf courses across the country. *Pebble Beach*, 155 F.3d at 533. Tour 18 copied the

[14] The Fourth Circuit in *Ashley Furniture* (187 F.3d at 371) and the Eighth Circuit in *Stuart Hall* (51 F.3d at 786) apply both *Seabrook Foods* and *Abercrombie*.

fourteenth hole from the famous Pebble Beach Course in Pebble Beach, California. The Pebble Beach company did not have a federal trademark registration, a copyright, or a design or utility patent on the design of the fourteenth hole. Rather, it sought to enjoin the defendant from copying the hole under a trade dress theory. Applying the *Abercrombie* factors to that claim, the court concluded that the golf hole was descriptive and, as such, could be protected only if it had acquired secondary meaning in the minds of the consuming public. *Id.* at 540-41.

The Fifth Circuit's rejection of the "inherently distinctive" categories – suggestive, arbitrary, or fanciful – is instructive. First, that court concluded that the golf hole could not be considered arbitrary or fanciful. Arbitrary and fanciful marks or trade dress must "bear no relationship to the products or services to which they are applied." *Id.* at 540 (citing *Zatarains, supra*, 698 F.2d at 791). The golf hole in question was an amalgamation of commonplace features of a golf hole, which clearly "bear a relationship to the product, a golf hole." *Id.* at 540. The court next concluded that the hole could not be suggestive. A suggestive mark or trade dress "suggests, rather than describes, some particular characteristics of the goods and services to which it applies and requires the consumer to exercise imagination in order to draw a conclusion as to the nature of the goods and services." *Id.* at 541 (citation omitted). Again, the court determined that the product configuration there – the features of the golf hole itself – created golf holes and nothing more. *Id.* at 540 ("They require no exercise of one's imagination to realize that one is viewing a golf hole."). Accordingly, the Court held that the golf hole designs could not be inherently distinctive under *Abercrombie*.[15] *Id.* at 540-41.

[15] In finding that a golf hole could not be inherently distinctive, the court specifically rejected an argument that, merely because a golf hole

As the *Pebble Beach* case illustrates, a product configuration cannot be inherently distinctive under the *Abercrombie* factors because the features of the trade dress sought to be protect constitute the product itself. This same observation is repeated elsewhere. For example, the Seventh Circuit noted that:

> [t]he only distinction courts make between trade dress generally and product configuration cases in particular is to require plaintiffs asserting a claim for infringement of trade dress in product configuration under § 43(a) of the Lanham Act to prove secondary meaning because a product's shape is never inherently distinctive.

Kohler Co. v. Moen, Inc., 12 F.3d 632, 641 n.11 (1993) (citing 1 McCarthy § 7:23[2] (collecting cases)).[16]

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design was "unique" among golf holes, it is inherently distinctive. The court refused to equate uniqueness with the inherent distinctiveness holding that: "[S]omething that is inherently distinctive is unique, but the converse is not necessarily true. A product may be unique and yet fail to be sufficiently distinctive to indicate source." *Id.* at 541 n.7 (citing 1 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:134 at 8-35 to 8-36 (3d ed. 1994)); *see also In re D.C. Comics, Inc.*, 689 F.2d 1042, 1050-51 (C.C.P.A. 1982) (Nies, J., concurring) ("[I] have found no precedent... which recognizes the protectability of any *product* design as a trademark for that product without proof of distinctiveness, that is, distinctiveness as an indicator *of origin*, not simply that it is a distinctive design in the sense of being unusual.") (Emphasis in original).

16 *See also* Bradley K. Groff, *Bare-Fisted Competition or Palming Off? Protection of Product Design as Trade Dress under the Lanham Act*, 23 A.I.P.L.A. Q.J. 65, 78 (1995) ("When the trade dress in question comprises the configuration or design of a product itself, it is difficult to imagine how it can be any more than 'descriptive' of the goods as in fact, it is the goods."). *Compare* Jay R. Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U.Ill. L. Rev. 887, 903 ("Unlike verbal marks, industrial designs do not describe anything; they 'just are.'").

A determination by this Court that *Abercrombie* applies, but that product configurations are always "descriptive" would certainly clarify the law, but not dramatically alter it. Indeed, this Court in *Qualitex* drew the same bright line recommended here with respect to the use of color as a mark. The Court acknowledged the classifications of *Abercrombie*, and concluded that there was no objection to the use of color alone as a trademark "where that color has obtained 'secondary meaning' (and therefore identifies a particular brand and thus indicates it's 'source')." *Qualitex*, 514 U.S. at 163; *see also id.* at 171-72 ("[Section 2(f) of the Lanham Act] permits an ordinary word, normally used for a nontrademark purpose (*e.g.*, description), to act as a trademark where it has gained 'secondary meaning.' Its logic would appear to apply to color as well.").

Although the Second Circuit has rejected the *Abercrombie* test in *Knitwaves, supra*, it drew the same lesson from this Court's *Qualitex* opinion: "[T]he Court [in *Qualitex*] concluded [that] a product's color is capable of indicating a product source, and thereby becoming eligible for trademark protection, only when it acquires secondary meaning as, over time, customers come to associate that color with the particular product." 71 F.3d at 1008 (citing *Qualitex*, 514 U.S. at 163). Just as *Qualitex* determined that color is neither arbitrary, nor fanciful, nor suggestive, the *Knitwaves* court similarly rejected those appellations in a product configuration setting:

> While 'arbitrary,' 'fanciful' or 'suggestive' packaging of a product may be presumed to serve this source identifying function and thus must be deemed *per se* distinctive of the source... the same presumption may not be made with regard to product features or designs whose primary purposes are likely to be functional or aesthetic.

Id. at 1008 (citation omitted); *see also* Restatement (Third) of Unfair Competition § 16, Comment b (1995) ("As a practical matter… it is less common for consumers to recognize the design of a product or product feature as an indication of source.… Product designs are therefore not ordinarily considered inherently distinctive and are thus normally protected only upon proof secondary meaning.").

C. A Construction That Requires Secondary Meaning In Product Configuration Cases Is Consistent With Public Policy As Expressed In The Common Law And By Congress In Design Patent And Industrial Design Legislation.

1. Section 43(a) is considered to be the federal codification of the common law of unfair competition. *See Two Pesos*, 505 U.S. at 780 (Stevens, J., concurring). The law of unfair competition "has its roots in the common law tort of deceit: its general concern is with protecting *consumers* from confusion as to source not the protection of providers as an incentive to protect innovation." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (emphasis in original). In *Bonito Boats*, a product configuration case, this Court adopted Judge Learned Hand's apt analysis in *Evescent Tool Co. v. Kilbow & Bishop Co.*, 247 F. 299, 301 (2nd Cir. 1917):

> [T]he plaintiff has the right not to lose his customers through false representations that those are his wares which in fact are not, but he may not monopolize any design or pattern, however trifling. The defendant, on the other hand, may copy plaintiff's goods slavishly down to the minutest detail: but he may not represent himself as the plaintiff in their sale.

Bonito Boats, 489 U.S. at 157.

Given this singular purpose – protection of consumers against confusion as to the source of the goods –

this Court should adopt a construction of § 43(a) which tracks common law consumer protection principles in product configuration cases. Those cases typically require secondary evidence that the goods in question designate source: "the common law of unfair competition has been limited to protection against copying of non-functional aspects of consumer products *which have acquired secondary meaning* such that they operate as a designation of source." *Bonito Boats*, 489 U.S. at 158 (citations omitted) (emphasis added).

2. This Court, in a trilogy of cases striking down state unfair competition laws because of federal preemption, has underscored the importance of fostering competition – indeed, exact copying – in promoting consumer welfare. *See Bonito Boats, Inc.*, 489 U.S. at 168 ("By offering patent-like protection for ideas deemed unprotected under the present federal scheme, the Florida statute conflicts with the 'strong federal policy favoring free competition in ideas which do not merit patent protection.'") (citation omitted); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 233 (1964) (unlimited protection against copying that Illinois law accorded to an unpatentable item conflicted with the federal policy embodied in the patent laws); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964) (an injunction against copying an unpatentable article impermissibly "interfere[d] with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."). [17]

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[17] *See also* Restatement (Third) of Unfair Competition § 16, Comment b (1995) ("[T]he competitive interest in copying product design is more substantial than in the case of packaging, containers, labels, and related subject matter.").

Collectively, those cases create a right to copy, free from state law restraints, the subject matter of expired design patents or matter which could have been patented under design patent law.[18] The source of preemption in these decisions is the design patent statute, 35 U.S.C. § 171. That provision allows the issuance of design patents to the inventor of "any new, original and ornamental design for an article of manufacture."[19] *Id.*; *see also Bonito Boats*, 489 U.S. at 148 ("To qualify for protection [under 35 U.S.C. § 171], a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability."). Justice O'Connor's opinion noted that the "Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition...." *Id.* at 146.

Many courts thus look to the design patent provisions also as an expression of Congress' intent on how far trademark protection should extend to designs. *See, e.g., Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1508 (10th Cir. 1995), *cert. denied*, 516 U.S. 1067 (1996) ("We conclude that patent law seeks the invention and the passing into the public domain of even what trade dress law would consider nonfunctional invention."); *Duraco, supra*, 40 F.3d at 1451 ("[I]f the

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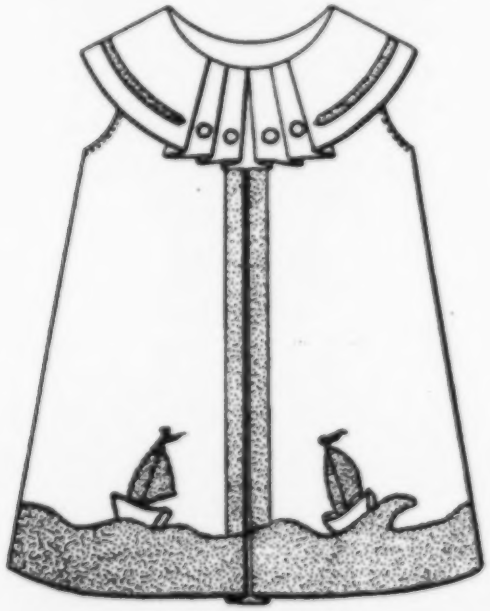
18 To be sure, the source of the *Sears/Compco/Bonito* rulings is the Constitution's Supremacy Clause – federal patent law preempts state unfair competition laws. Thus, the cases have no direct impact on the questions raised in the present case, involving the interpretation of separate federal statutes. *E.g., Ferrari SPA v. Roberts*, 944 F.2d 1235, 1241 (6th Cir. 1991), *cert. denied*, 505 U.S. 1219 (1992).

19 A design patent provides monopoly protection for 14 years. 35 U.S.C. § 173. And, like any patent, if the product is "on sale" for more than one year prior to application, no patent may issue. 35 U.S.C. § 102(b).

consumer is likely to be motivated, in some more than incidental part, to buy a product because of a particular combination or arrangement of features, other than because that configuration signifies a source of the product, the penumbra of the patent laws – granting others a right to copy what has been donated to the public domain – will deny protection unless secondary meaning is first shown.").

For more than 60 years, creative dress designers have been able to obtain patent protection for clothing designs. The patent laws cover dress designs and the Patent Office will register unique designs. Hence, there is no policy reason to distort the law of trade dress to incentivize invention in this field.

For example, in 1936 the Patent Office issued U.S. Patent Des. No. 98,883 for a "new, original, and ornamental Design for a Dress" illustrated in the patent itself as:



Patent designs such as this contain a precise graphic depiction of the protected design. Unlike the vague and inconsistent "look" that Samara seeks to protect, design

patents inherently protect creativity while minimizing any adverse effect on competition. It is comparatively easy for a competing designer to avoid infringing a design patent. The drawing in the public patent file clearly marks the limits of protection.

In sum, Congress expressed the balance between innovation and competition in the product design field with the design patent statute.[20] That balance should be

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20 Congress has also repeatedly considered, and rejected, the enactment of legislation proposed to extend further protection to industrial designs. The history of such legislation is chronicled in *Duraco*:

> Moreover, design protection laws (which have repeatedly been introduced in Congress during virtually every session since 1917) have not once been enacted. *See In re Nalbandian*, 661 F.2d 1214, 1218-19 & n.1 (C.C.P.A. 1981)(Rich, J., concurring) (recounting the history of efforts to pass design protection legislation); *Esquire, Inc. v. Ringer*, 591 F.2d 796, 800 n.12 (D.C.Cir. 1978) (observing that since 1914 none of the approximately 708 design protection bills introduced in Congress had passed); Brown, *Design Protection: An Overview*, 34 U.C.L.A. L. Rev. at 1395 ('Beginning in 1957, a [design protection] bill has been introduced in probably every Congress....'); Dratler, *Trademark Protection for Industrial Designs*, 1988 U.Ill. L. Rev. at 888 & n.4, 904 & n.94 (stating that the history of the effort to have Congress enact industrial design legislation takes up 160 pages in a Copyright Office bibliography, and that between 1914 and 1945 at least 45 such bills were introduced in Congress); A. Samuel Oddi, *The Functions of 'Functionality' in Trademark Law*, 22 Hous. L. Rev. 925, 951 & n. 147 (1985); Glieberman, Note, *Overbroad Protection of Product Trade Dress*, 45 Stan. L. Rev. at 2070 & nn. 251-52; *cf. Bonito Boats*, 489 U.S. at 167-68, 109 S.Ct. at 986 ('It is for Congress to determine if the present system of design and utility patents is ineffectual in promoting the useful arts in the context of industrial design').

Duraco, 40 F.3d at 1446-47.

maintained here by avoiding the extension of patent-like monopoly through trade dress doctrine.

Most recently, Congress last year considered, but did not pass, a bill to define trade dress protection. *See* H.R. 3163, Trade Dress Protection Act, 105th Cong., 2d Sess. (1998). Parties opposing the bill stressed that it provided too much protection in product configuration cases. For example, The International Trademark Association ("INTA"), representing 3,500 members who own trademarks and serve trademark owners, did not support H.R. 3163 and further supported a distinction between packaging and configuration cases. ("INTA believes that trade dress claims for product configuration should be subject to a stricter standard than those relating to product packaging. Otherwise, trade dress laws might be used to preclude the availability of competitive substitute products....") U.S. House of Representatives Committee on the Judiciary, Testimony of David Stimson (last visited Nov. 17, 1999) <http://www.house.gov/judiciary.41152.htm>.

* * *

In short, the Court has two independent bases for determining that product configurations are never inherently distinctive: (1) the statute itself and its legislative history, which mentions configurations as "marks" registrable on the supplemental register; and (2) application of the *Abercrombie* test (as adopted by the Court in *Two Pesos*), which requires secondary meaning for descriptive marks, such as configurations. Each rationale is consistent with the underlying purposes of the Lanham Act as expressed in the common law, the design patent law, and other Congressional efforts.

If, however, this Court concludes that Congress did not intend to differentiate "configuration" marks from others in the statute, and if the Court further holds that *Abercrombie*

does not apply, we suggest an alternative test of inherent distinctiveness – one essentially similar to the *Seabrook* test utilized by the U.S.P.T.O.

II.

IN THE ALTERNATIVE, A PRODUCT CONFIGURATION IS "INHERENTLY DISTINCTIVE" ONLY WHERE THE CONFIGURATION IS A CONSISTENT AND PARTICULAR DESIGN THAT IS SO UNIQUE AS TO BE AUTOMATICALLY, IMMEDIATELY, AND PRIMARILY PERCEIVED AS INDICATING ORIGIN.

We argue in the alternative for a bright line test of "inherent distinctiveness" which will, in very few cases, allow an applicant to claim protection without proof of secondary meaning. A high standard is consistent with the common law, where protection has traditionally been limited to "copying of non-functional aspects of consumer products which have acquired secondary meaning such that they operate as a designation of source." *Bonito Boats*, *supra*, 498 U.S. at 158.

We propose a test which is drawn from several sources: judicial precedent, the Restatement (Third) of Unfair Competition, and the standards set out in the U.S. Patent and Trademark Office Trademark Manual of Examining Procedure ("TMEP"). The proposed test for inherent distinctiveness is: *a consistent and particular design that is so unique as to be automatically, immediately, and primarily perceived as indicating source.*

A. Consistent and Particular.

In his thoughtful and provocative opinion in *Publications Int'l*, *supra*, Chief Judge Posner of the Seventh Circuit acknowledges the struggle the courts have had in determining a standard for when a trade dress is sufficiently

distinctive to be entitled to protection. Judge Posner understandably finds that "efforts to define intuitive concepts such as 'distinctiveness' are often both futile and unnecessary." *Publications Int'l*, 164 F.3d at 339. Nonetheless, the opinion states:

> Publishers who want to distinguish their look-alikes from their competitors' – who want, that is to make their trade dress identify the publisher – can easily do so by adopting a distinctive logo, imposing a *uniform* design, typeface, or color on the covers of their books, printing their name prominently on the covers, or doing all these things….

Id. at 343 (emphasis added). A key word in Judge Posner's litany is: "uniform."

In the context of a claim of trade dress covering a line of goods, where "[the] concern for protecting competition is particularly acute," a greater emphasis is placed on consistency. *Landscape Forms, Inc.*, *supra*, 113 F.3d at 380. As observed by Judge Newman in his dissent below, "[n]o case has upheld trade dress protection on an alleged 'line' of products that depicts entirely different decorative objects, rendered in a wide variety of combinations and different colors." (Pet. App. A at 35.) A good example of protectable trade dress for a line of products is *Harlequin Enterprises Ltd. v. Gulf Western Corp.*, 644 F.2d 946, 948 (2d Cir. 1981), where "every book in the Harlequin Presents series is uniform in its dimensions, cover design and colophon."

Similarly, a plaintiff must "articulate and support its claimed trade dress with sufficient particularity." *Landscape Forms*, 113 F.3d at 381. There must be "a precise expression of the character and scope of the claimed trade dress" so that the claim is not "pitched at a improper level of generality…." *Id.*; *see also* TMEP § 1202.03(c) ("If an acceptable statement describing the mark is not in the record,

the examining attorney must require the applicant to submit such a description so it is clear what the applicant is seeking to register."); *id.* ("[I]n an application to register a mark with three-dimensional features, [a] drawing shall depict the mark in perspective in a single rendition.").[21]

B. Unique.

The Restatement (Third) of Unfair Competition § 16, Comment b, observes that "[t]rade dress that is unique and prominent can thus be inherently distinctive." *See also* 1 McCarthy § 8:13 (4th ed. 1996) (stating that the test of inherent distinctiveness is "whether the design, shape or combination of elements is so unique, unusual, or unexpected in [the] market that one can assume without proof that it will be automatically perceived by customers as an indicator of origin.").

Similarly, the oft-cited *Seabrook Foods* test states:

> In determining whether a design is arbitrary or distinctive this court has looked to whether it was a "common" basic shape or design, whether it was unique or unusual in a particular field, [or] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods....

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21 As McCarthy explained:

> In some cases, neither the plaintiff nor the court defines exactly what the trade dress consists of, except for vague and indeterminate references to the 'overall appearance' or 'look'.... [T]his may well leave defendant uncertain as to what to do to avoid a charge of contempt and create dangers of anti-competitive over-protection....

1 McCarthy § 8:3.

Seabrook Foods, 568 F.2d at 1344; *see also Ashley Furniture, supra*, 187 F.3d at 371 ("[Under *Seabrook*], to qualify as inherently distinctive a design must be 'unique or unusual' in the 'particular field' at issue.").

The *Duraco* opinion is also instructive on this factor. The first element of that test for trade dress is that the product configuration be "unusual and memorable." *Duraco, supra*, 40 F.3d at 1449. That is, "it must partake of a unique, individualized appearance, so that a consumer informed of all the options available could reasonably rely on it to identify a source." *Id.*

C. "Automatically" Perceived As Indicating Source.

In *I.P. Lund*, *supra*, the First Circuit, construing *Seabrook*, stated that the test of inherent distinctiveness is: "whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will *automatically* be perceived by customers as an indicator of origin...." 163 F.3d at 40 (emphasis added) (citing 1 McCarthy § 8:13). The "automatically" factor is also consistent with *Qualitex*, where this Court distinguished color from "fanciful," "arbitrary," or "suggestive" words or designs, "which almost *automatically* tell a customer that they refer to a brand." 514 U.S. at 162-63 (emphasis in original).

D. "Immediately" Perceived As Indicating Source.

Under the TMEP § 1202.03(b)(i), the basic test for inherent distinctiveness employed by an Examiner in a product configuration case is "whether the purchasing public would immediately recognize the configuration as being a mark." (Emphasis added). This is consistent with Judge Posner's observation that an inherently distinctive trade dress allows a consumer to "know[] at a glance who made it...." *Publications Int'l*, 164 F.3d at 339.

E. "Primarily" Perceived As Indicating Source.

To be inherently distinctive, a mark must serve "primarily" as an indicator of source. This concept is drawn principally from the *Knitwaves*, *Landscape*, and *Duraco* opinions. *Knitwaves*, 71 F.3d at 1008; *Landscape*, 113 F.3d at 378; *Duraco*, 40 F.3d at 1449. The First Circuit in *I.P. Lund*, *supra*, also adopted this concept and found it consistent with the *Seabrook Foods* test. That is, part of a configuration's "distinctiveness" is determined by whether the design "is likely to serve primarily as a designator of origin of the product." *I.P. Lund*, 163 F.3d at 41 (citations omitted).

On this point, it is not the intent of the trademark owner that is determinative.[22] Rather, the issue is whether a person seeing the configuration would view the configuration primarily as an indicator of source or primarily as an expression of the product's utilitarian or aesthetic function.[23] In short, how would a person answer the question: what is the primary reason that this product looks this way?

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22 *See generally* 1 McCarthy § 8:13 (stating that "the intent of the designer is a very weak indicator of the likely reaction of potential customers.").

23 This Court in *Qualitex* acknowledged the "aesthetic functionality" doctrine as it is set forth in the Restatement. *Qualitex*, 514 U.S. at 170 (quoting Restatement (Third) of Unfair Competition § 17, Comment c, pp. 175-76 (1993))("[I]f a design's 'aesthetic value' lies in its ability to 'confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs,' then the design is 'functional.'"). By statute, a mark that is functional is non-registrable. Lanham Act § 2(e)(5), 15 U.S.C. § 1052(e)(5). Some view the "functionality" of a mark as the "primary legal rubric" for assessing the proper scope of trademark protection for configurations. Jay R. Dratler, Jr., *Intellectual Property Law*, § 9.02[3](b) at p. 9-34.11 (1999 ed.).

The TMEP is also instructive on this point: "Subject matter which is merely a decorative feature of part of the 'dress' of the goods does not identify and distinguish the applicant's good and, thus, does not function as a trademark. Such matter should be refused registration because it is merely ornamentation and thus, does not function as a trademark...." TMEP § 1202.04.

F. Indicating Source.

The principal purpose of the Lanham Act is to protect only those marks that are source-identifying. 15 U.S.C. § 1127; *Two Pesos*, 505 U.S. at 768. In order to be inherently distinctive, then, the proposed trade dress must be inherently distinctive as to the source of the goods. This element is consistent with the definition proposed by McCarthy: "whether the design, shape or combination of elements is so unique, unusual, or unexpected in the market that one can assume without proof that it will be automatically perceived by customers *as an indicator of origin*." 1 McCarthy § 8:13 (emphasis added).

III.

UNDER EITHER ALTERNATIVE, SAMARA DOES NOT HAVE PROTECTABLE TRADE DRESS.

Applying the proper law to the facts of this case leads to an inescapable conclusion: Samara's line of children's garments is not a protectable trade dress. Whether compelled by statute, by the *Abercrombie* test, or by a revamped definition of inherent distinctiveness, the garments, while aesthetically pleasing, are not source-identifying.

Under the statutory construction discussed in Section I, the Samara trade dress is not protectable. The claimed trade dress consists entirely of design features of the products themselves – children's clothing; as a

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"configuration of goods," it cannot be inherently distinctive under the Lanham Act as Congress constructed that statute. In the alternative, the trade dress is necessarily "descriptive" under the *Abercrombie* test and has not been buttressed by a showing of secondary meaning. (*See* Pet. App. A at 8.)

Under the alternative standard proposed above in Section II, the trade dress claimed by Samara does not qualify for protection:

- The claimed trade dress is not consistently applied to all Samara garments and cannot be described with particularity.
- The claimed trade dress uses a common fabric and common elements and thus is not "unique."
- The viewer's "immediate" and "automatic" response to the garment is not an association with the source of the goods, but is a response to the aesthetics.
- The "dress" itself is not "primarily" source-identifying, but is aesthetic.

As a result, even if this Court determines that trade dress could be inherently distinctive, it should nonetheless find Samara's trade dress not to be inherently distinctive, or, in the alternative, remand the case to the Second Circuit for reconsideration of that issue under the standard enunciated in this case.

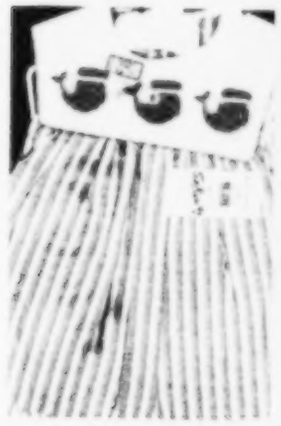
A. Samara's Claimed Trade Dress Is Not Consistent, Nor Is It Particularly Described.

Samara's claimed trade dress does not meet the first element of the proposed alternative test and, hence, cannot be found to be inherently distinctive. It fails to meet that element because: (1) the "Samara look" does not demonstrate a consistent or uniform trade dress; and (2) the claimed trade dress cannot be articulated with particularity.

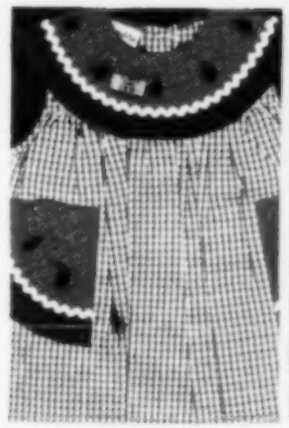
1. The record before this Court contains a number of color photographs of the children's clothing manufactured by Samara and sold under the Samara label. (*See* J.A. 287-327.) A review of those garments, as was found by the Court of Appeals, shows that the trade dress claimed by Samara is not consistent throughout the Samara line. (*See* Pet. App. A at 20 & n.5.)

A sampling of those garments are reproduced on the next page to illustrate the inconsistency of the designs: the dresses have different silhouettes (*e.g.*, garments 2, 3, 4, 6), different applique arrangements (*e.g.*, garments 2, 3, 4, 6), and different colors (*e.g.*, garments 2, 4, 5, 6); some have scalloped collars (*e.g.*, garment 7), some have split collars (*e.g.*, garment 4), some have no collar at all (*e.g.*, garments 3, 6, 8); some have pockets (*e.g.*, garments 2, 4), some do not (*e.g.*, garments 1, 3, 5); some are two-piece (*e.g.*, garments 4, 6), some are one-piece (*e.g.*, garments 2, 3, 5); some have appliques inside the collar line (*e.g.*, garment 5), some have appliques along the collar line (*e.g.*, garment 7), and some have appliques that make up the entire collar (*e.g.*, garment 2, 9).

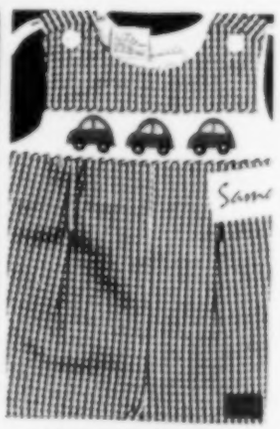
Examples of Garments Included in the "Samara Look"



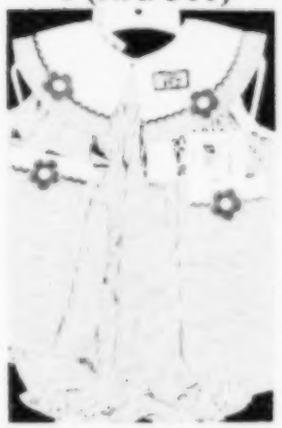
1 (J.A. 311)



2 (J.A. 297)



3 (J.A. 295)

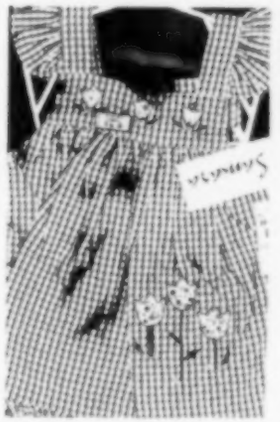


4 (J.A. 322)

5 (J.A. 294)

6 (J.A. 288)

7 (J.A. 317)



8 (J.A. 304)

9 (J.A. 326)

The Second Circuit's definition of Samara's trade dress further demonstrates the inconsistent nature of the so-called "look":

> The protected trade dress will include most if not all of the following: seersucker fabric used exclusively; two or three identically shaped and symmetrically placed cloth appliques (not screen printed) substantially similar to appliques displayed on Samara clothing in vibrant colors integrated into the collar (which is typically large and white), collar line and/or pocket(s) (if any); single-piece, full-cut bodies; and the absence of three dimensional features, outlines, and words.

(Pet. App. A at 18-19.) This definition, which grants protection to any Samara good that demonstrates "most if not all" of a number of inconsistent design elements (such as "typical" use of large, white collars and appliques "integrated" into the "collar, collar line and/or pockets (if any")), goes well beyond that which Congress intended to be protected under the Lanham Act, and cannot be found to be inherently distinctive. *Compare Harlequin, supra*, 644 F.2d at 948.

In his dissent, Judge Newman pointedly noted that "that many of the products in the alleged product line do not have all of even the few features that are claimed to constitute the 'look.'" (Pet. App. A at 34; *see generally id.* at 32-36.) For instance, he noted that, despite the majority's requirement that the appliques be "incorporated into either a full collar or the collar line of the garment," a number of the garments for which trade dress protection was granted did not even have collars.[24] (*Id.; see also* J.A. 295.)

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[24] Judge Newman noted that of the 14 garments the majority found within its new definition, "four do not have the applique integrated on the

In fact, the Second Circuit definition of the "Samara look" is even inconsistent with the trade dress claimed by Samara. The court of appeals rejected all of the trade dress definitions that Samara had used, rejected the definition adopted by the trial court, and, instead created its own new definition that had never been suggested prior to the decision. In so doing, the majority expressly included elements of the Samara "look" that Samara itself expressly disclaimed at trial. (*See* Pet. App. A at 20; J.A. 38, 101.)

At trial, Wal-Mart's counsel drew the following sketch of a collar and appliqué design in the courtroom on a large presentation flip chart:

(J.A. 256)

After Wal-Mart's counsel had completed that sketch, he asked the witness, Gary Goldman, Samara's Vice President of Sales and one of Samara's two design witnesses, whether the drawing embodied "the Samara look." Mr. Goldman responded "no." (J.A. 103.) Yet the majority's definition of the protected trade dress plainly encompasses that courtroom sketch: seersucker garments with three identically shaped and symmetrically placed cloth appliques substantially similar to Samara appliques... integrated into large, white collar. (*See* Pet. App. A at 18-19.)

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collar or pockets; in two products, the applique is placed on the top front of the main fabric of the dress, and in the remaining two products, on a mid-riff running across the main fabric of the dress." (Pet. App. A at 34.)

The invalidity of the majority's decision is further evidenced by the fact that the majority found that unless a garment was made of "seersucker fabric," it could not have the "Samara look" since seersucker fabric was an essential aspect of Samara's protectable trade dress. (Pet. App. at 20.) That conclusion, however, is flatly inconsistent with the testimony of Samara's own witnesses. At trial, Mr. Goldman was asked whether one would "have to have seersucker with this [design] for this to be the Samara look?" Again, he unequivocally replied, "no." (J.A. 103.) Indeed, Samara's President, Don Gaffney, had already specifically testified that Samara's claims were not based on the use of seersucker fabric. (J.A. 38) ("Q: And you don't have any problem with Wal-Mart using seersucker? A: No. Q: So to the extent that you may have made claims in this case for infringement based upon use of particular seersucker pattern you are not making that case now, are you? A: No.")

2. Samara has never been able to define a consistent and particular trade dress, and the Court of Appeals compounded that problem by defining the protected dress as a "combination" of inconsistent elements. The fact that Samara has never been able to articulate a specific "look" demonstrates the indefiniteness of Samara's claimed trade dress and should preclude a finding of inherent distinctiveness.

The established rule in the Second Circuit requires a plaintiff relying on the product design, rather than the packaging, as a basis for a trade dress claim to set forth and prove "a precise expression of the character and scope of the claimed trade dress." *Landscape Forms,* 113 F.3d at 381. The absence of a clearly articulated and definite description "may indicate that [the plaintiff's] claim is pitched at an improper level of generality, *i.e.,* the claimant seeks protection for an unprotectable style, theme or idea." *Id.* Samara's claim is just such an unallowable indefinite claim.

It is so broad that, if it were allowed, it would effectively create a perpetual monopoly in the manufacture of seersucker children's clothing with appliques.

The totally amorphous nature of Samara's trade dress claim was evident in its Complaint as well as its trial evidence.[25] The Complaint described the "Samara look" as:

- a "clean" and uncluttered appearance;
- carefully coordinated combinations of silhouettes, applique designs, fabric patterns and colors;
- placement of the appliques on the garment in order to produce a unified appearance, often by integrating the appliques to the collar and/or the pockets;
- conservative, classic styling that remains consistent from year to year rather than changing with fashion; and
- specially designed stylized appliques selected for consistency across the line.

(J.A. 14-15.) Later, the claimed "look" was described by Samara's counsel in his opening statement as "clean and bright without a lot of lace and frills and bows... very traditional, very classic." (J.A. 25.)

Samara's claim was not sharpened by its evidence at trial. If anything, the claim became more ambiguous. Samara's witnesses themselves, the actual creators and designers of the claimed "Samara look" could not articulate what, if anything, constituted the trade dress. (*See, e.g.*, J.A. 46-60.) Katherine Gosda, Samara's chief design witness and

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[25] The majority itself noted that "the complaint provides an insufficient description of the of the 'inherent distinctiveness' of the trade dress to qualify for protection." (Pet. App. A. at 13 n. 2; *see also* J.A. 295.)

a self-described leading authority on the "Samara look" (*see* J.A. 75-76), testified that the "look" is "simple-like elegance, or simple sophistication." (J.A. 49.) She went on to explain that the "look" is "hard to put into words.... [i]t just looks like I said, simple sophistication." (*Id.*) Gary Goldman, Samara's Vice President of Sales and only other design witness, was no more definite. (J.A. 103) ("Q: What would make the Samara Look? A: It's just the feel of the garment. It's something that you have to understand being there doing it for 15 years, caring about it maybe.").

Despite their repeated attempts to define their look, the Samara witnesses were unable to give a clear and specific articulation of the look they claimed was unique to Samara-designed clothing. The trial judge recognized that the trade dress definition offered by Samara was too vague and refused to include any provision in the initial injunction based on claims of trade dress, finding that "Samara has not been able to suggest sufficiently specific language." (Pet. App. B at 54.)

When the products making up the claimed "look" are totally inconsistent, and the designers cannot articulate a definition of the "look," and a court cannot find "sufficiently specific language" to describe the trade dress for purposes of an injunction, the trade dress cannot be inherently distinctive.

B. The Claimed Trade Dress Consists Of Common Elements That Are Not Unique To Children's Garments.

Samara's claimed trade dress is made up of elements that are so common to children's garments – such as the use of seersucker and heart, flower, and fruit appliques; the placement of appliques on collars, pockets, and chests – that they cannot be inherently distinctive.

1. The elements of Samara's trade dress as found by the Second Circuit are by no means unique to children's garments. First, seersucker is, without question, a common element of children's garments. (*See* Pet. App. A at 33, Newman, dissenting) ("Seersucker fabric is not at all distinctive."). Indeed, despite the Second Circuit's findings that seersucker was an essential element of the "look," Samara did not even attempt to claim protection for the fabric. (*See* J.A. 38, 103.) Ms. Gosda further testified that strawberries, hearts, tulips, cars, sailboats, and the use of ric rac are all common themes in children's clothing. (J.A. 70-71).

Ms. Gosda also agreed that appliques are a traditional method of decorating children's garments. (J.A. 72.) It is quite common to place those appliques on the collars and pockets of children's garments. (*See, e.g*, J.A. 205, 208, 238, 241, and 244; *see also* Pet. App. A at 33, (Newman, J., dissenting) ("The use of large collars is also extremely common, and the fact that appliques are placed on the collar, or pockets, if any, is hardly noteworthy.")). Indeed, it is hard to imagine any other location on a children's garment – outside of the collar, pockets, and chest – to place an applique.[26]

As an example of how common some of Samara's designs are in the industry, Wal-Mart submitted a "design your own" dress pattern from Simplicity. (J.A. 255.) That pattern provides instruction on how to create your own seersucker, girl's dress with a large watermelon applique collar, a dress that is virtually identical to a Samara garment

[26] The majority specifically found a garment with cars running across the chest to be within the trade dress, despite its earlier finding that "appliques incorporated into either a full collar or the collar line of the garment" is an essential, "major design element." (*See* Pet. App. A. at 20 & n.5.)

that the Second Circuit found to be within Samara's trade dress. (*Compare* J.A. 255 *with* J.A. 297.)

2. Moreover, Samara's own witnesses acknowledged that other companies make garments that have the "Samara look." Mr. Goldman explained that other companies may not make an entire line with the "look" but that particular garments within their lines do look like Samara's. (J.A. 97) ("Q: So with respect to the one garment [made by another company], however, that garment might look like the Samara garment, that is your testimony? A: I would say yes."). And, Ms. Gosda, Samara's chief design witness, a designer of Samara children's garments for six years, affirmatively testified that a garment manufactured by a competitor, Baby Togs, had the "Samara look." (J.A. 64; *see also* J.A. 239). She was also uncertain as to whether a dress manufactured by All Mine, was a Samara. (J.A. 80; *see also* J.A. 205; *and see* J.A. 189 and 241 (competitors' garments falling within the Second Circuit's trade dress definition)).[27]

In sum, Samara's claimed trade dress consists of elements that are not sufficiently unique to be considered inherently distinctive.

C. The Claimed Trade Dress Consists Of Common Design Elements That Enhance The Product's Aesthetic Appeal, But Are Not Automatically, Immediately, And Primarily An Indicator Of Source.

Samara's claimed trade dress does not meet the last elements of the proposed alternative test because: (1) the "Samara look" is not automatically and immediately

[27] All of the garments sold by Wal-Mart had labels that clearly showed that they were not Samara garments. (*See, e.g.*, J.A. 156, 159, 161, 162, 163, 167, 169, 174, and 176.)

perceived as an indicator of source; (2) Samara's use of private brand labels demonstrates that "look" is not the indicator of source; and (3) the "look" is primarily aesthetic, and not source-identifying. Hence, because Samara's "look" does not satisfy this element, it cannot be inherently distinctive.

1. The claimed "Samara look" is not automatically perceived as an indicator of source. Indeed, Karen Gosda, Samara's chief design witness, admitted that it took her "a while" to "learn" the look, testimony that is directly inconsistent with a finding that the look is "automatically" and "immediately" distinctive as to source. (J.A. 49) ("When I first started working at Samara it took me a while to get it because I came from different companies that did things much more racy.... Like I said, it took me a while.... There is something I had to learn.").

2. Further, Samara allowed its trade dress to be used on many children's garments sold under other brand names. (*See, e.g.*, J.A. 39-41.) This demonstrates the importance of labels as an indicator of source – the brand name is a much more effective, immediate, automatic, and primary indicator of source. *See Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F.Supp. 595, 603-604 (S.D.N.Y. 1996) (quoting *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977 (2d Cir. 1987) ("labels, more than design, 'provide a traditional means of identifying the manufacturer of clothing.'").

3. Lastly, even the creator of the "look" disavows any claim that the garments indicate source. Ms. Gosda's testimony on what she intended to create when she designed the "Samara look" proves beyond any doubt that Samara intended its "look" to serve aesthetic, rather than source identifying, purposes.

> "I make it what I called rounded. I want them to be soft, cute, that kind of thing.... I made it simple.... I made it rounded and I split the window, just to make it a little interesting." (J.A. 46-47.) "It's cute." (J.A. 48.) "It's simple. It's not too hard on the eye.... [It's] nice and balanced, symmetrical..." (*Id.*)

When asked to explain the garments comprising the look, Ms. Gosda testified: "They are not too simple where you are bored with them but they are simple. They look sophisticated. They look boutiquey. They look very, very nice." (J.A. 49.)

Further, Samara's advertising makes clear that, if anything, its name, not its designs, tell consumers the source of the product. Indeed, the only three exhibits offered by Samara to show advertising all referred to the trade name "Samara." (J.A. 198, 199, and 200.) And two of the garments displayed in the advertising are not even covered by the Second Circuit's revamped trade dress definition. (*E.g.*, J.A. 200 (large single applique); J.A. 199 (two-piece garment)).

Because Samara's trade dress does not automatically, immediately, and primarily serve as an indicator of source, it cannot be inherently distinctive.

CONCLUSION

For the reasons stated, this Court should hold as a matter of law that the trade dress claimed by Samara cannot receive judicial protection. Alternatively, this Court should clarify the uncertainty in trade dress doctrine that has plagued the judiciary and remand this case for re-consideration by the Court of Appeals for the Second Circuit in light of that clarification.

Respectfully submitted,

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